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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,124	01/08/2002	Frank Butaric	CRD-0903	5306

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PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/041,124	Applicant(s) BUTARIC ET AL.	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.  
 7) ☒ Claim(s) 7 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO 1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3/17/04, 1/12/04, 7/21/03  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

The drawings corrections were received on October 6, 2003. These drawings are approved.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The last line of claim 1 recites "where said extension prosthesis extends through another portion of said aneurysm". Applicant has claimed a portion of the body (another portion of said aneurysm), which is considered non-statutory subject matter. It is suggested to change "extends through" to recite --is configured to extend through--. Use of such language as configured, shaped, adapted, etc., eliminates the positive recitation of part of the body.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-6, and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Marcade (USPN 5,683,449). Marcade discloses a system for bypassing an aneurysm comprising a bypass prosthesis (112) having a proximal (136) and distal end (138 or 140), a stent (154) and a graft (152; fig.2), and an extension prosthesis (114 or 116) having a stent (154) and a graft (152; fig.2), the stent having a larger diameter at a proximal end (114a, 116a), with a flare (col.10, lines 12-15; col.11, lines 57-63), wherein the proximal end (114a, 116a) of the extension stent corresponds to the distal end (138, 140) of the bypass prosthesis (112, see fig.1, 2, 3G, 3I), matingly engaging and overlapped to form a fluid tight seal (col.11, lines 3-8). Marcade discloses the bypass prosthesis (112) to inwardly taper (looking at it one way, the leg of 112 tapers inwardly from point 140 upward, looking at it another way, 112 taper inwardly downward, starting at a first diameter at 136 and having a smaller diameter at 140) and the extension prosthesis (114, 116) to outwardly taper (col.10, lines 12-15; col.11, lines 57-63). Marcade discloses a sealing prosthesis (110) configured to receive a proximal end (136) of the bypass prosthesis (112). Marcade discloses a connector for engaging the bypass (112) with the extension prosthesis (114, 116; col.18, lines 48-55). Marcade discloses an anchor in a distal portion of the extension prosthesis (the stent functions as an anchor, and barbs are also disclosed to be used). Marcade discloses at least two markers (142, 146, 126, 128, 124, 122) positioned on the bypass and extension prosthesis (fig.2; col.10, lines 22-30).

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Claims 1-3, 5, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (USPN 5,653,743). Martin discloses a system for bypassing an aneurysm comprising a bypass prosthesis (19) having a proximal and distal end, a stent and a graft (fig.5; col.4, lines 21-30, wherein graft refers to graft with support, col.2, lines 58-60), and an extension prosthesis (1) having a stent (3) and a graft (2), the stent (1) having a larger diameter at a proximal end (5; fig.1), with a flare, wherein the proximal end (5) of the extension stent (3) corresponds to the distal end of the bypass prosthesis (19; fig.5; col.4, lines 21-22), matingly engaging and overlapped to form a fluid tight seal. Martin discloses the bypass prosthesis (19) to inwardly taper (col.4, lines 21-22) and the extension prosthesis (1) to outwardly taper (fig.1; col.2, lines 61-65). Martin discloses a connector (stent functions as a connector) for engaging the bypass (19) with the extension prosthesis (1) and an anchor (stent functions as an anchor, or anchor could be 18, seen in fig.5) in a distal portion of the extension prosthesis (1).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcade (USPN 5,683,449). Marcade discloses a system having a bypass prosthesis (112) overlapping an extension prosthesis (114, 116) by a length (fig.1, 4, 3H), however is silent to disclose specific dimensions for the overlap. It would have been an obvious matter of design choice to have an overlap of 30-50mm, since such a modification would have involved a mere change in the size of

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a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

*Allowable Subject Matter*

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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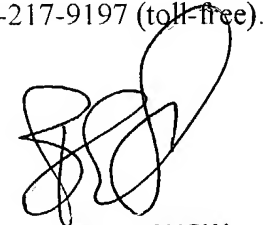
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER